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IN THE

Supreme Court of the United States

OCTOBER TERM, 1931.

No. 506.

AMERICAN TRADING COMPANY,
Petitioner,
vs.
H. E. HEACOCK CO.,
Respondent.

WM. A. ROGERS, LTD., and AMERICAN TRADING COMPANY,
Petitioners,
vs.
H. E. HEACOCK CO.,
Respondent.

PETITION FOR WRITS OF CERTIORARI TO THE SUPREME COURT OF THE PHILIPPINE ISLANDS.

Petitioners pray for writs of certiorari to review the final judgments of the Supreme Court of the Philippine Islands, entered March 7, 1931 (R. 543), in the above entitled cases, denying a rehearing and affirming (R. 289-302) in both cases the judgments of the Court of First Instance in favor of the respondent and against the petitioners.

On August 15, 1931, *Mr. Justice Butler* of this court made an order in each case extending for a period of sixty days from September 7, 1931 (that is, until and including November 6, 1931), the time for presenting this petition for certiorari to this court (R. 558).

Statement of the Case.

These were two actions, both begun in the Court of First Instance for the Judicial District of Manila, Philippine Islands. In the first case the complaint was filed January 12, 1928, by H. E. Heacock Co., the respondent here, as plaintiff, against American Trading Company, one of these petitioners, as sole defendant in that action (R. 2-5) for an injunction to prevent petitioner American Trading Company, from selling within the Philippine Islands nickel, or silver plated, or silver goods of any kind (R. 5),

> "under any mark where the name—ROGERS—is used, and from any other means by which the public may be induced to believe that the flatware imported and sold by the defendant is the flatware imported and sold by this plaintiff and known as —ROGERS—flatware,"

and for an accounting and damages.

The second case was a cross action in which the complaint was filed the following day, January 13, 1928 (R. 10-15), by these petitioners, Wm. A. Rogers, Ltd., a Canadian corporation, doing business in Toronto and in Niagara Falls, New York (R. 30, *correcting the erroneous allegations in the complaint* [R. 10] *of its being a New York corporation*), and American Trading Company, a corporation of the Philippine Islands, against the respondent, H. E. Heacock Co., plaintiff in the first action, as defendant, to enjoin it, H. E. Heacock Co., "from further interference with the business of these plaintiffs conducted under" the trade-mark *Wm. A. Rogers, E. P. N. S.* and other trade-marks set out in the complaint in that action

(R. 11, 14),* and for damages and general relief. A preliminary injunction was issued in that second action against the respondent, H. E. Heacock Co. (R. 15-17); answers were filed in both cases (R. 5-9; 18-21); and a cross complaint in the second case by H. E. Heacock Co. against Wm. A. Rogers, Ltd., alone (R. 21-25); and an answer to the cross complaint (R. 25-27). By stipulation the cases were tried together (R. 103-193); and on March 11, 1929, the Court of First Instance (*Imperial, J.*), handed down his decision in both cases (R. 193-248) in favor of the respondent, H. E. Heacock Co., plaintiff in the first case and defendant and cross complainant in the second case, and entered judgment accordingly (R. 247-248) perpetually enjoining these petitioners, Wm. A. Rogers, Ltd. and American Trading Company,

> "from importing and selling in the Philippine Islands silver plated wares for use in the table and for other purposes similar to those imported and sold by the plaintiff, bearing the trade-mark 'Rogers,'"

and for damages and an accounting; and overruled petitioner's motion for a new trial (R. 249).

Petitioners appealed to the Supreme Court of the Philippine Islands (R. 249) which, as above, stated, affirmed the Court of First Instance in both cases.

The Facts Involved.

The case turns upon the right of these petitioners to bring into the Philippine Islands from the United States and to sell in the Philippine Islands flatware manufac-

* The letters "E. P. N. S." and "E. P. B. M.," and the letter and figure "A-I," appearing as though they were parts of the trade-marks, as alleged in the cross-complaint, and copied in the opinion of the Philippine Supreme Court (R. 11; 282), are really quality or grade-marks, and no part of the registered trade-marks—"E. P. N. S." stands for "Extra Plated Nickel Silver"; "E. P. B. M." for "Extra Plated Britannia Metal—"A-I" is self-explanatory. Apparently Philippine counsel, in drafting the cross-complaint, simply copied all the marks appearing on samples of flatware or on labels submitted to them. The additions are of no importance, one way or the other, in this litigation. The letters are well known trade symbols.

tured in the United States bearing the trade-mark "Wm. A. Rogers," and the other trade-marks (shown on page 11 of the record) duly registered in the United States under the Federal trade-mark law at different times from 1906 to 1917, and owned by petitioner Wm. A. Rogers, Ltd., for whom the other petitioner American Trading Company, is the Philippine agent.

The respondent, H. E. Heacock Co., a Philippine corporation organized in 1909, is a silverware dealer in the Islands, and in 1918 registered there as a trade-mark under the local law (Philippine Act No. 666) the word ROGERS (*simpliciter*).

Fifteen years earlier, on March 6, 1903, the second Taft Commission, then exercising legislative powers in the Philippine Islands under the "Philippine Bill" (the Act of Congress of July 1, 1902, C. 1369, 32 Stat. 691) had enacted Philippine Act No. 666 (*Appendix I* hereto) as a local trade-mark act for the Islands, to replace the Spanish decrees theretofore in force. At that time there was no Federal trade-mark law in force in the Islands. The Federal Trade-Mark Law of 1881 then in existence (Act of March 3, 1881, C. 138, 21 Stat. 502) by its express terms, limited its protection to persons "domiciled in the United States," a phrase which, as used in that Act, has uniformly been construed not to include the Philippine Islands (*cf.* Opinion of Attorney General Knox, 23 Ops. Attorneys General 634, 636).

Afterwards, in 1905, there was enacted the present Federal Trade-Mark Act (Act of Congress of Feb. 20, 1905, C. 592, 33 Stat. 724) containing provisions expressly extending it to "all territory which is under the jurisdiction and control of the United States" (Sec. 29; Appendix IV, *infra*, p. 50); and, later on the local Philippine Act No. 666 was amended by inserting in it a new Section 14 containing a proviso that:

> "this section shall not be construed to affect rights that any person may have acquired by virtue of having registered a trade-mark under the laws of the United States" (Amendatory Philippine Act No. 2460, February 4, 1915; *Appendix II, infra*).

After the enactment of the Federal Trade-Mark Law of 1905, the petitioner Wm. A. Rogers, Ltd. registered in the United States at different times between 1906 and 1917 (Exhibits 7, 8, 9, 10 and 11, R. 158-184), the following trade-marks (R. 11, 282):

WM. A. ROGERS
1881 R ROGERS R
W. R.
WM. A. ROGERS (in old English script)

and has since used and now owns them.

Note: One of the above quoted trade-marks includes as part of the mark the figures "1881." Those figures, enclosed in wreaths in the trade-marks, are simply parts of the mark. These were all re-registered after 1905 under the present Federal Law (Exhibits 7, 8, 9, 10, 11, R. 158-184).

Later on, i. e., in 1918, as above stated, *after all those trade-marks had been registered in the United States by the petitioner Wm. A. Rogers, Ltd.,* the respondent Heacock registered in Manila, under the local law, the word ROGERS, as above stated (R. 2). Heacock and its predecessors in business, for some years prior to 1918, perhaps from as early as 1901 (R. 210), had been advertising and selling in the Islands, flatware bought from the International Silver Company, bearing one or another of the Silver Company's trade-marks containing the word ROGERS in various combinations (R. 45-46); and this it continued to do after its 1918 registration of the word ROGERS, and up to the present time. It does not appear that it has ever manufactured any such silverware itself, or that it has ever sold, either in the Islands or elsewhere, any silverware bearing as a trade-mark the word ROGERS, *simpliciter* (R. 40-42, 45, 47-48, 291).

In securing such trade-mark registration in 1918, the Heacock Company was in fact acting merely as the agent of and for the benefit of International Silver Company. The Philippine Supreme Court expressly so finds (R. 290).

Both the International Silver Company and petitioner Wm. A. Rogers, Ltd., were, and still are, the owners (R. 296) of various trade-marks, registered in the United States, containing the word ROGERS in various combinations, for use on flat silver.

Long prior to the H. E. Heacock Company's 1918 registration in Manila of the word ROGERS, litigation over their respective trade-marks had been carried on in various Federal and State Courts between International Silver Company and William A. Rogers, Ltd., and/or their respective predecessors in title, or other parties using the word ROGERS; and the rights of the various users of the word ROGERS in the United States had been established and defined as among themselves; so that it was well settled that neither International Silver Company, nor petitioner Wm. A. Rogers, Ltd., had the exclusive right to use the word ROGERS; but that each of them was entitled to use its own trade-marks containing the family name ROGERS in various distinguishing combinations.*

In 1924, or a year earlier or later (R. 30-31), the petitioner Wm. A. Rogers, Ltd., began sending to the Philippine Islands for sale, and selling there, through the other petitioner American Trading Company, as its Philippine agent (R. 29), its flatware bearing its United States registered trade-marks, of the same designs and put up in the same dress as that in which it had been and still is rightfully selling it in the United States, in competition with the International Silver Company.

Respondent Heacock's claim in this suit, in which it has been upheld by the Insular Courts as above stated (*ante*, p. 3), is that, under its local registration in 1918, of the word ROGERS, *simpliciter*, it is entitled to exclude the Wm. A. Rogers, Ltd. ware from the Philippine markets.

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* Some of the cases are cited in the opinion of the Court of First Instance (R. 218-227, 242-244). See, also, R. 389.

Opinions of the Insular Courts.

The Court of First Instance of Manila expressly held (R. 212-216) that the Federal Trade-Mark Law, the Act of February 20, 1905,

> "regarding trade-marks and patents has not been extended or made applicable to the Philippine Islands" (R. 216)

and is not in force there; and the opinion of the Insular Supreme Court impliedly so holds, and expressly holds that the effect of the *proviso* in Section 14 of the local law, Act No. 666, as added by Philippine Act No. 2460,

> "* * * *Provided, however,* that this section shall not be construed to affect rights that any persons may have acquired by virtue of having registered a trade-mark under the laws of the United States,"

is limited to the purposes of that one section of the Act, alone (R. 297-298); thus confining the effect of the *proviso* simply to securing to shippers to the Philippines of goods bearing federally registered trade-marks, the naked right, solely (R. 297),

> "of the importation of merchandise into the Philippine Islands and its entry at any custom house, * * * and that nowhere in Section 14 is the word 'sale' or 'sell' used";

and thus holding (R. 297) *that the right to import and enter such goods at the custom house in the Philippine Islands in interstate or foreign commerce does not include the right to sell them in the Islands.*

The opinion does not mention either the provisions of Section 10 of the Organic Act (Act of Congress of August 29, 1916, Chap. 416, 39 Stat. 545, 548; Appendix VI, p. 52, *infra*) that the trade relations of the Islands shall be "governed exclusively by laws of the Congress of the United States," nor that of Section 26 of the Tariff Act for the Philippines (the Act of Congress of August 5, 1909, Chap. 8, 36 Stat. 130, 177; Appendix V, p. 51,

infra), expressly conferring upon the Philippine courts jurisdiction in matters arising under the Federal Trade-Mark Act of 1905.

Questions Presented.

1. Could the International Silver Company, either in its own name or in the name of respondent Heacock as its agent, validly register under the local Philippine law the word ROGERS, *simpliciter*, and thus exclude from sale in the Philippine Islands ware manufactured in the United States bearing the trade-marks of its competitor, Wm. A. Rogers, Ltd., validly registered under the Federal law and confirmed by final decisions of the Federal and State Courts.

2. May one of two parties, both of whom, under final decisions of Federal and State Courts, are entitled to register and use the same name as a part of their respective trade-marks, afterwards go to a possession of the United States, and there, through an agent or otherwise, validly register, as against the other, a broader trade-mark, consisting of that name standing alone, and thereby exclude the other from using the name as he has lawfully registered and used it in the United States?

(a) And particularly may he do so without selling in the Islands any goods bearing the locally registered trade-mark, but selling in the Islands only goods bearing trade-marks registered in the United States none of which consist of the locally registered trade-mark—in this case the name "Rogers"—standing alone.

(b) As against such a local registration, may not his United States competitor sell, in the Islands, goods manufactured in and exported from the United States, of the same designs, and put up in the same way in which he is accustomed competitively to sell them in the United States, and bearing its own trade-marks, *registered and adjudi-*

cated in the United States before such *local registration* in the Islands?

3. May an importer located in the Philippine Islands, such as the respondent Heacock Company in this case, importing and selling in the Islands goods manufactured in the United States, bearing federally registered trade-marks, validly register under the local law, as his trade-mark, a word or name broader than or different from the trade-marks actually appearing on the goods so imported and sold, and thereby acquire for himself, or for his manufacturer, broader trade-mark rights than those he could have secured by registration of the trade-marks actually appearing on the goods?

4. Does the Federal Trade-Mark Act of 1905 apply to the Philippine Islands?

5. Section 13 of the local Philippine trade-mark law, Act No. 666, prohibits registration of marks identical with a "registered or known trade-mark owned by another and appropriate to the same class of merchandise." Shall this phrase, "registered or known trade-mark," be construed to refer only to marks registered in the Philippine Islands; or does not the term "registered or known trade-mark," as thus used in the Act, include also marks registered in the United States under the Federal Trade-Mark Act of 1905?

6. Shall the trade-mark laws of the Philippine Islands be so construed as to permit registration by one person of a personal family name (not his own) as a trade-mark, thereby debarring all persons rightfully using that name from its use in the Islands as a trade name, either by itself, standing alone, or in combinations—particularly in sales in the Islands in interstate or foreign commerce?

7. Does the right, recognized by the Philippine Trade-Mark Act, Section 14, to bring into the Philippine Islands

goods bearing trade-marks rightfully registered in the United States under the Federal law, include only—as the Philippine Supreme Court holds in this case—the bare and empty right to land the goods in the Islands and to enter them in the custom house or does it include also the right to sell them in the Islands in the ordinary course of business?

Reasons for Granting the Writ.

This case presents important questions of law of general public interest, which have not been determined by this court.

If the decision of the Philippine Supreme Court correctly states the law, it means in effect:

(1) That the registration of trade-marks in the United States under the Federal Trade-Mark Act of 1905 is of no practical force or effect or benefit for any purpose in the Philippine Islands.

(2) That any single one of a group of competing concerns here, all of which use various competing trade-marks, registered here under the Federal law, and all of which marks include a common word or name—(such as the name "Rogers" in this case)—may cause an importer in the Philippine Islands, as its agent or on its behalf, to register such word or name under the local Philippine Trade-Mark Act No. 666, and may thus completely debar from the Islands all its various competitors' goods marked with any trade-mark which includes such word or name, and may thus not only wholly debar its competitors from the Philippine trade, but also deprive the Islands of the benefit of such competition.

(3) That any business concern in the United States—or for that matter any concern anywhere in the world—

although aware of the registration of a trade-mark in the United States under the Federal law, may in effect pirate such a trade-mark, and debar its owner from using it in commerce with the Philippine Islands, by a local registration of a generalized similar mark or name under the local law of the Islands.

(4) That the construction placed by the Philippine Supreme Court upon the local Trade-Mark Act No. 666—particularly upon the final *proviso* to Section 14, as added by Act No. 2460—viz., that, while it permits entry at the custom house in the Islands of goods sent there from the United States bearing federally registered trade-marks, yet it forbids their sale in the Islands—really nullifies the *proviso*, deprives shippers of their rights in interstate commerce, and practically closes the Islands to interstate and foreign commerce in such goods.

Conclusion.

If this be the law, then it is of the utmost public importance that those trading with the Philippine Islands should know it at once.

It is, therefore, respectfully submitted that this petition for writs of certiorari to review the final judgments of the Supreme Court of the Philippine Islands in these cases should be granted.

HARRY D. NIMS,
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1931

No. 506

AMERICAN TRADING COMPANY,
Petitioner,
vs.
H. E. HEACOCK CO.,
Respondent.

WM. A. ROGERS, LTD., and AMERICAN TRADING COMPANY,
Petitioners,
vs.
H. E. HEACOCK CO.,
Respondent.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

I.

The opinions of the Courts below.

The opinion of the Philippine Supreme Court has not yet been officially reported. It was handed down on November 21, 1930, and is printed on pages 278 to 302 of the Record. The opinion was written by Mr. Justice Johns and concurred in by Chief Justice Avenceña and Justices Street, Malcolm, Romualdez and Villa-Real. Justice John-

son did not take part and Justice Ostrand reserved his vote (R. 302). Petitioner's motion for rehearing and a new trial was denied on March 7, 1931, by an order without any written opinion. Justice Ostrand dissented and Justices Johnson and Villamor took no part (R. 543).

The opinion of the Court of First Instance for the Judicial District of Manila (Imperial, J.) is not officially reported. It was handed down on March 11, 1929, and is printed on pages 193 to 248 of the Record.

II.

Jurisdiction.

The final judgment of the Supreme Court of the Philippine Islands denying petitioner's motion for rehearing and a new trial was entered March 7, 1931 (R. 543).

On August 15, 1931, Mr. Justice Butler made an order in each of these two cases extending the time for presenting this petition for certiorari for a period of sixty days from and after September 7, 1931 (R. 558). The jurisdiction of this Court to review the judgments of the Supreme Court of the Philippine Islands is invoked under Section 7 of the Act of February 13, 1925 (c. 229, 43 Stat. 936).

The case involves more than $25,000 (R. 544-555) and involves also questions of the construction and applicability of Acts of Congress, to wit: of the United States Trade-Mark Law of 1905 (Act of Congress of February 20, 1905, c. 592, 33 Stat. 724, as amended); of Section 10 of the Organic Act for the Philippine Islands reserving to Congress exclusive jurisdiction over the commercial relations of the Islands (Act of August 29, 1916, c. 416, 39 Stat. 545-547); and of Section 26 of the Tariff Act for the Philippine Islands of August 5, 1905 (c. 8, 36 Stat. 130, 177), conferring upon the Philippine courts jurisdiction in matters arising under the Federal Trade-Mark Act of February 20, 1905, identical with the jurisdiction conferred by Section 17 of that Act upon courts of

the United States, and also the construction of the Philippine Trade-Mark Law of March 6, 1903 (Act No. 666 of The Philippine Commission, as amended).

III.

The questions presented.

The questions presented are stated in the petition (*ante*, pp. 8-10).

IV.

Statutes involved.

The following are the statutes involved:

1. The Federal Trade-Mark Law, Act of Congress for February 20, 1905 (c. 592, 33 Stat. 724), particularly Sections 1, 16 and 29 (Appendix IV, *infra*, pp. 49-50).

2. The Philippine Trade-Mark Law, Act No. 666 of the Philippine Commission, approved March 6, 1903, as amended. This is copied in full for the convenience of the Court as is also the amendatory Act No. 2460, enacted February 4, 1915 (Appendices I and II, *infra*, pp. 37-48).

3. The Philippine Tariff Act of August 5, 1909 (c. 8, 36 Stat. 130, 177, Sec. 26; Appendix V, p. 51, *infra*).

4. The "Jones Law," the organic Act for the Philippine Islands, Act of Congress of August 29, 1916, Sections 5, 10 and 26 (c. 416, 39 Stat. 545; Appendix VI, pp. 52-53, *infra*).

V.

Statement of the case.

The statement of the case is in the petition (*ante*, pp. 2-3).

VI.

Specification of Errors to be Urged.

The errors to be urged are those stated in petitioner's Application for Rehearing and Motion for New Trial, submitted to the Philippine Supreme Court on December 19, 1930 (R. 303-400), and in the arguments there presented in support of the several points, and also in petitioner's Exceptions and Notice of Petitioner for Writ of Certiorari filed on March 11, 1931 (R. 545-551), to which the attention of this Court respectfully is invited.

SUMMARY OF ARGUMENT.

I. The Insular Courts erred in holding that the Federal Trade-Mark Act of 1905 is not in force in the Philippine Islands, and in failing to recognize that petitioner's registrations made under that act were effective in the Philippine Islands.

The Court based its reasoning upon a provision in the Jones Law of 1916 to the effect that statutes *"hereafter* enacted" shall not extend to the Philippine Islands unless those Islands are specifically mentioned. The Court disregarded the fact that the Trade-Mark Act of 1905, which, by its terms extends to all territory that is under the jurisdiction and control of the United States, was enacted *before* 1916. That the Trade-Mark Act of 1905 is applicable to the Philippine Islands has been consistently held by the Attorney General, the Treasury Department and in the Customs Regulations published by the Philippine Insular Government. It is expressly recognized in Section 26 of the Act of Congress of August 5, 1909, which is the tariff act for the Philippine Islands, and also in Section 14 of the Philippine Trade-Mark Law (Brief, pp. 19-22).

II. The Insular Courts erred in not holding that respondent's registration under the name ROGERS *simpliciter*

was invalid, because neither the respondent nor its principal, International Silver Company, used the name ROGERS *simpliciter* as a trade-mark. The silverware sold by Heacock was stamped with one or another of International Silver Company's United States trade-marks containing the name ROGERS in various combinations, but never *simpliciter*. Consequently, since the name ROGERS *simpliciter* was not applied or affixed to the goods, the Philippine registration of ROGERS *simpliciter* was invalid, because trade-marks to be registered must have been applied and affixed to the goods both under the provisions of the Trade-Mark Act of 1905 and under the local Philippine Trade-Mark Law (Brief, pp. 23-24).

III. The Insular Courts erred in holding that a personal name such as ROGERS, standing alone and not distinctively written or combined with other distinctive material, was registrable as a trade-mark so as to debar other persons or concerns rightfully entitled to use the same name as a part of their trade-mark from so using it.

The Federal Trade-Mark Law of 1905 contains a provision that a personal name cannot be registered unless distinctively written or displayed, but the Philippine local trade-mark law does not contain any provision expressly prohibiting the registration of a personal name or requiring that it be written in a distinctive way or combined with other distinctive material.

In so holding the Court treats a personal name exactly the same as if it were a fanciful or arbitrary word, and in effect holds that a personal name can be registered so as to debar all other persons or concerns having that name, and legally entitled to use it, from so doing without being guilty of infringement. In support of this proposition the Court of First Instance, in accordance with the settled rule, as declared by the Philippine Supreme Court, that the local trade-mark Act is a reduction to statutory form of the established principles of English and American trade-mark law, cited cases decided in the United States, involving the name "Rogers" itself and also other names;

but it turned out on examination of these cases that they hold diametrically opposite to what the Insular Court decided.

This extreme view taken by the Court was not taken by the Bureau of Commerce and of Industry of the Philippine Islands which, in 1930, permitted petitioner to register its trade-mark "Wm. A. Rogers" notwithstanding Heacock Company's previous registration of the name Rogers *simpliciter* (Brief, pp. 24-29).

IV. The Philippine Supreme Court should have held that the prohibition contained in Section 13 of the local Philippine Trade-Mark Law against the registration of a mark identical or similar to a registered or known trade-mark extends to infringement of marks registered under the Federal law and, therefore, that the Heacock registration of the name ROGERS was invalid under the Federal law (Brief, p. 30).

V. Irrespective of the technical validity or invalidity of the respondent's registration, petitioner was entitled to send its goods, marked with its trade-marks registered in the United States, to the Philippine Islands, and to sell them there in the ordinary course of business.

This right is expressly recognized in the Philippine local trade-mark law itself in Section 14, which contains a proviso saving the rights of owners of trade-marks registered in the United States from the prohibitions contained in that section against importing goods bearing trade-marks similar to trade-marks registered in the Philippine Islands.

The Philippine Supreme Court held, however, that the only right saved by this proviso was the empty right to land the goods in the Islands and enter them in the Custom House. This is a narrow and destructive interpretation of the saving clause and in conflict with the decisions of this Court that "the right to sell any article imported was an inseparable incident to the right to import it" (*Leisy* v. *Hardin*, 135 U. S. 100, 111) (Brief, pp. 31-33).

VI. The respondent Heacock Company, which registered the name Rogers in the Philippine Islands, was the agent of International Silver Company, and the Philippine Supreme Court held that in making the registration it was acting with the consent and for the benefit of International Silver Company. International Silver Company and its predecessors, by reason of the litigation which occurred between them and petitioner and its predecessors, were fully aware of petitioner's registrations and the right to use its trade-marks containing the name ROGERS in commerce with the Philippine Islands. Obviously, notice to the International Silver Company was notice to its agent, Heacock Company. Respondent's Philippine registration of the name ROGERS was, therefore, a clear case of piracy. So that, even if the registration technically conformed to the provisions of the trade-mark law, it is unconscionable to give it any effect against petitioner, and the Insular Courts erred in so doing (*Ubeda* v. *Zialcita*, 226 U. S. 452) (Brief, pp. 33-35).

ARGUMENT.

POINT I.

The Federal Trade-Mark Act of 1905 is in force in the Philippine Islands.

A. The Court of First Instance held that the Federal Trade-Mark Law of 1905 is not in force in the Philippine Islands, concluding (R. 216):

> "In view of the foregoing, it may be concluded that the aforesaid Act of Congress of the United States of February 20, 1905, regarding trade-marks and patents has not been extended or made applicable to the Philippine Islands";

and the Insular Supreme Court, affirming the Court of First Instance, ignores the Federal Act, and treats it, as did the Court of First Instance, as not in effect in the Islands (R. 278, 286 *et seq.*).

B. In so holding, the Court of First Instance placed its decision upon the ground that (R. 213):

> "In Section 1 of the Philippine Act, Act of Congress of July 1, 1902, it is provided that the provisions contained in Section 1891 of the Revised Statutes of 1878 shall not be applicable to the Philippine Islands. From this rule, it may be clearly inferred that the denomination 'The United States' should not be understood as including Philippine territory * * *."

R. S. 1891 provides that:

> "The Constitution and all laws of the United States which are not locally inapplicable shall have the same force and effect within all the organized Territories and in every Territory hereafter organized as elsewhere within the United States."

The "Jones Law," the Organic Act for the Philippine Islands (Act of Congress of August 29, 1916, Chap. 416, 39 Stat. 545, 547), provides in Section 5 that the statutory laws of the United States "*hereafter enacted*" shall not apply to the Philippine Islands, "except when they specifically so provide." The Court cites an opinion of the Attorney General (32 Ops. Atty.'s Gen. 550; October 17, 1925) as to the application of the Narcotic Drugs Act of 1922, to the effect that in view of the Jones Law, taken in connection with the Philippine Act of 1902, *supra*, the general provision contained in the Narcotic Drugs Act extending it in *general terms* to "all territories under the control of the United States," was not sufficient to carry it to the Philippine Islands, because those Islands were not specifically mentioned.

C. But the Insular Court, in so applying to the case at bar the reasoning of the Attorney General as to the Narcotic Drugs Act of 1922, overlooked two distinguishing features:

(1) The Federal Trade-Mark Act of 1905 was enacted *before* the "Jones Law" of 1926, whereas the Narcotic

Drugs Act of 1922 was enacted *after* the passage of the "Jones Law." Consequently the provision of Section 5 of the "Jones Law," that the statutory laws of the United States *"hereafter enacted"* shall not apply to the Islands, "except when they specifically so provide" applies, of course, directly to the Narcotic Act of 1922; *but does not affect the Trade-mark Law of 1905, enacted eleven years before the passage of the "Jones Law."*

(2) The Court also—*particularly in dismissing petitioner's cross-action for want of jurisdiction* (R. 216)—ignored the provision of Section 26 of the Act of Congress of August 5, 1909 (Chap. 8, 36 Stat. 130, 177; Appendix V, *infra*, p. 51), the Tariff Act for the Philippines, *which expressly confers upon the Philippine courts the same jurisdiction in actions arising under the Trade-Mark Act of 1905 as is conferred upon the Federal courts in the continental United States by Section 17 of the Federal Trade-Mark Act*, thereby expressly recognizing and providing for the application of the Trade-Mark Act of 1905 to the Philippine Islands. And this jurisdiction is continued under the "Jones Law," which provides (Sec. 26):

> "The Supreme Court and the courts of first instance of the Philippine Islands shall possess and exercise jurisdiction *as heretofore provided* and such additional jurisdiction as shall hereafter be prescribed by law." (Italics supplied.)

This provision is specifically referred to in the concluding paragraph of Section 14 of the Philippine Trade-Mark Act as amended (Appendix II, *infra*) wherein the Philippine Legislature confers upon the Philippine courts, for the purposes of that Section 14, jurisdiction identical with the jurisdiction conferred upon them by Congress under the Tariff Act of 1909.

D. It may be added that the Attorney General of the United States expressly held in 1909 that the Trade-Mark Act of February 20, 1905, extends to the Philippines, because of its express provisions extending it to "all terri-

tory which is under the jurisdiction and control of the United States" (27 Ops. Atty.'s Gen. 623, 624; September 24, 1909).

And the Treasury Department has consistently so held (Customs Regulations of 1908, Art. 325; Appendix VIII, *infra*, p. 54).

E. The Customs Regulations published by the Insular Government likewise recognize the Federal Act as in force in the Islands, and state (Customs Administrative Order No. 194, January 13, 1926, Par. I; Appendix VII, *infra*, p. 53) that the local law, Act No. 666 as amended,

> "contains the rules and regulations of the government of the Philippine Islands relative to property in *domestic* trade marks and trade names and the protection to be afforded the owners thereof, while the Act of Congress of February 20, 1905, as amended, provides for the registration and protection of trade marks used in connection with *foreign* nations or between the Philippine Islands and the several States of the United States."

It is submitted, therefore, that since the Trade-Mark Act of 1905 is in force in the Philippine Islands, the petitioner's registrations ran to the Philippine Islands and were in effect registrations in the Philippine Islands antedating Heacock's registrations. Congress is the sole source of law in the Philippine Islands, and by making the Trade-Mark Act of 1905 applicable to those Islands it introduced an additional method of securing registrations which would be effective in the Philippine Islands. Thereafter, the local Trade-Mark Act remained in effect only for the purpose of registering marks which were used in local businesses having no interstate or foreign commerce feature. In this respect, the situation is different from that which might arise in one of the States in the United States, where a separate legislative sovereignty exists and where Congress has only those powers which are granted to it by the Constitution.

POINT II.

Respondent's Philippine registration of the name Rogers *simpliciter* was invalid, because neither respondent nor its principal, International Silver Company, used the name Rogers *simpliciter* as a trade-mark.

Heacock Company did not sell silverware which it made or on which it had placed any trade-mark whatever. Its business consisted in importing from the United States and selling in the Philippine Islands flatware made by International Silver Company which bore one or more of the various trade-marks registered by International Silver Company in the United States, and which contained the name ROGERS, *not simpliciter,* but in various combinations, such as "Rogers Bros.," etc. Consequently, neither the Heacock Company nor its principal, International Silver Company, ever applied the name ROGERS *simpliciter* to the goods.

Under the Trade-Mark Law of 1905, a trade-mark to be registrable must have been applied to the goods (Sec. 1; Appendix IV, p. 49, *infra*). The Philippine local Trade-Mark Law (Act 666) expressly distinguishes between trade-marks and trade names. It is clear from the language of Section 1 of the local act relating to trade-marks, and that of Section 5 relating to trade names, and that of Section 11, sub-paragraph First, relating to registration, that a trade-mark must be one which is "applied and affixed to the goods" (Appendix I, p. 41, *infra*).

In *Hay* v. *Malone,* 273 Fed. 363, 364 (1921), the Court of Appeals of the District of Columbia said:

> "It is unnecessary to pass upon appellant's right to register the word 'Hay-Po' alone, since it does not appear that he has ever used it in trade independent of the other features of the mark as above shown. There must be actual trade-mark use to entitle the owner to registration. Hence appellant must stand or fall upon the actual use of the mark."

Heacock's certificate of registration describes it as "a trade-mark for spoons and other flatware." But Heacock did not affix to the goods which he sold a trade-mark consisting of the name ROGERS *simpliciter*. Instead, the goods sold by Heacock bore various trade-marks such as "ROGERS 1847" and other marks embodying the name ROGERS in various combinations, as registered by the International Silver Company in the United States (R. 42). Consequently, the statement in the application for registration, that "the trade-mark is applied or affixed to the goods by stamping or engraving or applying the same in any other suitable manner, to the back, bottom, side, edge or the top of the goods, wherever convenient, or is also applied by the printing of labels placed upon the packages containing the goods," is false. Since the name ROGERS *simpliciter* was not one of the trade-marks applied and affixed to the goods sold by Heacock, the registration thereof is clearly invalid, both under the Trade-Mark Act of 1905 and under the Philippine Trade-Mark Law.

POINT III.

The Insular Courts erred in holding that a personal name such as Rogers, standing alone and not distinctively written or combined with other distinctive matter, was registrable as a trade-mark under the local Philippine Law so as to debar other persons, rightfully entitled to use the same name as part of their trade-mark, from so using it.

Heacock's application for registration was for a trade-mark consisting of the name ROGERS alone, printed in plain block letters. It was neither printed nor combined with other matter in such a way as to be distinguishable from any other Rogers.

It is true that the Philippine local Trade-Mark Law does not contain any express provision prohibiting the registration of a personal name or requiring that it be printed in

a distinctive way or combined with other distinguishing matter, but the Court of First Instance based its decision on this point largely upon certain decisions in the United States relating to the name ROGERS and other names, which clearly hold that a personal name, standing by itself and not in any distinctive form or combination, is not susceptible of exclusive appropriation or registration so as to debar other persons or concerns who are rightfully entitled to use that name as part of their trade-mark.

It is submitted that, irrespective of the silence of the Philippine Trade-Mark Statute on this point, a registration of a name which cannot be exclusively appropriated cannot be held to debar others who have a right to use that name in their trade-mark from so using it. The Court of First Instance in its opinion cited the following cases: *International Silver Co.* v. *Simeon L. & George H. Rogers Co., et al.*, 110 Fed. 955, 956, 959; *International Silver Co.* v. *Rogers*, 67 Atl 105, 106, 107; *Henderson* v. *Peter Henderson & Co.*, 9 Fed. (2nd), 787, 788, 789, 790; *Andrew Jergens Co.* v. *Bonded Products Corporation*, 13 Fed. (2nd), 417, 423-424; *Coty, Inc.* v. *Perfume de Grande Luxe*, 298 Fed. 865, 866-867, 869,887, 871, 873-876, 877-878; *Borden Ice Cream Co.* v. *Borden's Condensed Milk Co.*, 201 Fed. 510, 513-514; *Wm. Rogers Mfg. Co.* v. *Rogers & Spurr Mfg. Co.*, 11 Fed. 495, 499-500.

The following quotations from some of these very cases cited by the Court, clearly show that it is uniformly held that a personal name is not the subject of exclusive appropriation:

Coty, Inc. v. *Perfume de Grande Luxe*, 298 Fed. 865, 874 (R. 235-236):

> "It is well-settled law that the mere name of an individual cannot become a valid technical trade-mark as against others bearing the same name. In Brown Chemical Co. v. Meyer, 139 U. S. 540, 11 Sup. Ct. 625, 35 L. Ed. 247, the Supreme Court declared that it was hardly necessary to say that an ordinary surname cannot be appropriated as a trade-mark by any one person as against others

of the same name, who are using it for a legitimate purpose. In that case Mr. Justice Brown, who was writing for the court said:

> 'A man's name is his own property, and he has the same right to its use and enjoyment as he has to that of any other species of property. If such use be a reasonable, honest, and fair exercise of such right, he is no more liable for the incidental damage he may do a rival in trade than he would be for injury to his neighbor's property by the smoke issuing from his chimney, or for the fall of his neighbor's house by reason of necessary excavations upon his own land. These and similar instances are cases of damnum absque injuria.'
>
> And see McLean v. Fleming, 96 U. S. 245, 24 L. Ed. 828; Singer Manufacturing Co. v. June Manufacturing Co., 163 U. S. 169, 16 Sup. Ct. 1002, 41 L. Ed. 118; Elgin National Watch Co. v. Illinois Watch Case Co., 179 U. S. 655, 21 Sup. Ct. 270, 45 L. Ed. 365; Howe Scale Co. v. Wyckoff, Seamans & Benedict, 198 U. S. 118, 134, 25 Sup. Ct. 609, 49 L. Ed. 972; Stix, Baer & Fuller Dry Goods Co. v. American Piano Co., 211 Fed. 271, 127 C. C. A. 639; William Rogers Manufacturing Co. v. Simpson, 54 Conn. 527, 9 Atl. 395" (R. 235, 236).

Borden Ice Cream Co. v. *Borden's Condensed Milk Co.*, 201 Fed. 510, 513:

> "A personal name, such as 'Borden,' is not susceptible of exclusive appropriation, and even its registration in the Patent Office cannot make it a valid trade-mark. Howe Scale Co. v. Wyckoff, 198 U. S. 134, 25 Sup. Ct. 609, 49 L. Ed. 972; Elgin Natl. Watch Co. v. Illinois Watch Case Co., 179 U. S. 665, 21 Sup. Ct. 270, 45 L. Ed. 365; Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169, 16 Sup. Ct. 1002, 41 L. Ed. 118; Brown Chemical Co. v. Meyer, 139 U. S. 540, 11 Sup. Ct. 625, 35 L. Ed. 247.
>
> There is no charge made in the bill that the appellants are infringing, or propose to infringe, upon any technical trade-mark of the appellee, so we may dismiss any claim for relief upon that score" (R. 241).

International Silver Company v. *Wm. H. Rogers Corporation,* 66 N. J. Eq. 120, 57 Atl. 1037, cited in *International Silver Co.* v. *Rogers,* 67 Atl. 105 (R. 225):

> "The complainant is the successor of several companies which have been engaged for many years in the manufacture of silver-plated ware and which all derived their title from three brothers by the name of Rogers. * * * While a personal name may not constitute a technical trade-mark, yet where an article has come to be known by that personal name one may not use that name, even though it be his own, to palm off his goods as the goods of another who has first adopted it, and by which appellation the goods have come to be known, when the use of his own name for such purpose works a fraud. If he uses his own name it must be so used as not to deprive others of their rights * * *."

In that case the Court of Errors and Appeals required the defendant to distinguish his goods by an explanatory phrase; it did not bar his use of the name Rogers.

Andrew Jergens Co. v. *Bonded Products Corporation,* 13 Fed. (2d) 417, 422 (R. 230), at 422:

> "The court should be most cautious not to interfere, without proper cause, in business ventures between individuals, and the right of a man to use his own name has rarely been prohibited."

This language is not included in the Court's quotation. From this case, however, the language quoted by the Court is that of the Supreme Court in *Singer Mfg. Co.* v. *June Mfg. Co.,* 163 U. S. 169, 188, 16 Sup. Ct. 1002, 1009, 41 L. Ed. 118:

> "The fair and honest use of a person's own name in his ordinary and legitimate business, although to the detriment to another, will not be interfered with."

The Circuit Court of Appeals, affirming the decree in *Jergens* v. *Bonded Product Corporation,* 21 Fed. (2nd)

419, approved the following language of Judge Morris in another case involving this particular trade-mark, namely, *Andrew Jergens* v. *Woodbury*, 273 Fed. 952:

> "It cannot be denied that the evidence discloses that some confusion exists in the public mind as to the origin of the articles of the respective parties, yet, so far as I have been able to discover from the evidence, such confusion as does exist arises from the exercise of the legal rights of the respective parties, and not from any wrongful act of the Distributors. Such confusion seems wholly attributable to the fact that two separate and distinct corporations, deriving their title from a common source, have the right to use the same mark and name upon different articles and preparations of the same general class, and to the further fact that an individual has, subject to certain conditions (observed, I think, by the Distributors), the right to use his name in his business, although his surname may have acquired a secondary meaning, and to transfer that business to a corporation bearing his name."

Consequently, the conclusion to which the Court of First Instance arrived (R. 244), "having demonstrated by adjudicated decisions that the word 'Rogers' is susceptible of appropriation and registration," is diametrically opposite to the holdings in the adjudicated decisions cited by the Court.

These decisions represent the well settled principles of American and English trade-mark law which the Philippine Supreme Court itself has held to have been embodied in Act No. 666. In *Spinner & Co.* v. *Neuss Hesslein Corp.*, 28 Phil. Off. Gaz. 1939 (Jan. 13, 1930), the Philippine Court said (p. 1941):

> "The law governing trade-mark rights as well as unfair competition in this jurisdiction is found in Act No. 666 of the Philippine Commission, which is a reduction to statutory form of the jurisprudence developed by the courts of England and the United States in connection with the subjects mentioned; and to the summary of substantive law expressed in

the statute are added the provisions relative to the registration of trade-marks."

See also:

Dy Buncio v. *Tan Tiao Bok,* 42 Phil. Rep. 190 (1921).

Certainly, the name ROGERS *simpliciter* was not susceptible of exclusive appropriation by International Silver Company or its agents as against Wm. A. Rogers, Ltd., in view of the decisions in the various courts in the United States holding that both were entitled to use that particular name in their respective trade-marks. It is submitted that under these circumstances neither International Silver Company nor its agent, Heacock, was enentitled to register the name ROGERS *simpliciter,* or to use such a registration to debar Wm. A. Rogers, Ltd., from the use of its adjudicated trade-marks. Under the Philippine law a registration is only *prima facie* evidence of right (Philippine Trade-Mark Act, Sec. 16; Appendix I, *infra,* p. 44). The Philippine Courts erred in not giving effect to the clearly demonstrated right of this petitioner to use, as against International Silver Company and its agents, trade-marks incorporating the personal name "Rogers."

The Insular Courts apparently treated Heacock's registration of the name ROGERS *simpliciter* in the same way as if it were a fanciful or arbitrary term, thus disregarding the necessarily limited right which even a registration of a personal name can give. The decision of the Insular Courts was, in effect, that because of the registration of the name ROGERS by Heacock, no one else, no matter what his name, could use the name ROGERS in any form for silverware in the Philippine Islands without infringing Heacock's registration. It is submitted that Heacock's registration, even if technically valid, could not have any such broad effect. And this was the view taken by the Bureau of Commerce and Industry in the Philippine Islands when, in 1930, it registered petitioner's trade-mark "Wm. A. Rogers" and other trade-marks of petitioner containing the name ROGERS (R. 295-296).

POINT IV.

Respondent's Philippine registration of the name Rogers is invalid because the Philippine Trade-Mark Law provides (Sec. 13) that no trade-mark shall be registered "which is identical with a registered or known trade-mark owned by another and appropriated to the same class of merchandise, or which so nearly resembles another person's lawful trade-mark or trade-name as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers."

As shown above under Point I, the Federal Trade-Mark Law of 1905 extends to and applies in the Philippine Islands. Consequently, petitioner's trade-marks registered under that law were registered and known trade-marks in the Philippine Islands prior to the time of Heacock's registration. Since the Trade-Mark Act of 1905 is in effect in the Philippine Islands, as shown under Point I, a mark registered under that Act in any statute relating to the Philippine Islands must be deemed a registered trade-mark. So far as the word "known" is concerned, Heacock was International Silver Company's agent, and whether he personally knew of the petitioner's trade-marks or not, is immaterial. His principal knew of them and notice to his principal is sufficient.

It is no answer to the above argument that Heacock's mark was registrable because ROGERS *simpliciter* is different from "Wm. A. Rogers, Ltd.," i. e., not identical with "Wm. A. Rogers, Ltd.," nor so similar to it as to cause confusion. If that view were to be taken, then it would necessarily follow that "Wm. A. Rogers, Ltd.," would not be an infringement of ROGERS *simpliciter*, and the whole case against the petitioner would fall.

POINT V.

Irrespective of the validity or invalidity of respondent's Philippine registration of the name Rogers, petitioner was entitled to send its goods, marked with its United States registered trade-mark, to the Philippine Islands, and sell them there.

This right already exists by virtue of petitioner's earlier United States registrations under the Federal Trade-Mark Act; which is applicable to trade-marks used in commerce between the states and with foreign nations. Moreover, this right is specifically recognized in Section 14 of the Philippine Trade-Mark Act forbidding the importation of goods bearing trade-marks similar to registered trade-marks but containing the following proviso: "That this section shall not be construed to affect rights that any person may have acquired by virtue of having registered a trade-mark under the laws of the United States."

The Philippine Supreme Court held, however, that the right thus secured by the Federal law, and expressly recognized by the local law, is limited to the empty right to land the goods in the Islands and enter them in the custom house.

It is believed that no argument is necessary to show that this was error. The right to send goods to the Islands in interstate commerce includes the right to sell them there and to deliver them to purchasers. It is not the bare and useless right of landing and entering them in the custom house and leaving them there. The construction given by the Court to the proviso in Section 14 of the local act would make it plainly violative not only of the interstate commerce right secured by the Federal Trade-Mark Law to the owners of federally registered trade-marks but also of the provisions of Section 10 of

the Jones Law, the Organic Act for the Islands (Appendix VI, *infra*, pp. 51-52), that

> "the trade relations between the Islands and the United States shall continue to be governed exclusively by laws of the Congress of the United States."

The local law cannot properly be so construed as to burden interstate or foreign commerce with the Islands nor as to discriminate against goods lawfully brought into the Islands in such commerce nor to prevent or burden their sale and delivery therein. *Brown* v. *Maryland*, 12 Wheat. (25 U. S.) 419, 439, 441-449; *Texas Co.* v. *Brown*, 258 U. S. 466, 476, 477; *Sonneborn* v. *Cureton*, 262 U. S. 506; *Howe Machine Co.* v. *Gage*, 100 U. S. 676, 677-679; *Welton* v. *Missouri*, 91 U. S. 275, 278-283; *Leisy* v. *Hardin*, 135 U. S. 100-110-125:

> "The power which insures the uniformity of commercial regulations must cover the property which is transported as an article of commerce from hostile or interfering legislation, until it has mingled with and become a part of the general property of the country, and subjected like it to similar protection, and to no greater burdens. If, at any time before it has thus become incorporated into the mass of property of the state or nation, it can be subjected to any restrictions by State legislation, the object of investing the control in Congress may be entirely defeated * * * (p. 281).
>
> "* * * It is sufficient to hold now that the commercial power continues until the commodity has ceased to be the subject of discriminatory legislation by reason of its foreign character. That power protects it, even after it has entered the State, from any burdens imposed by reason of its foreign origin" (p. 282).

Welton v. *Missouri*, *supra*, 91 U. S. 275, 281, 282.

> "* * * Not to be stopped at the external boundary of a State, but must be capable of enter-

ing its interior; *that the right to sell any article imported was an inseparable incident to the right to import it.*"

Leisy v. *Hardin, supra,* 135 U. S. 100, 111.

"What can be the use of the contract, what does the importer purchase, if he does not purchase the privilege to sell?

What would be the language of a foreign government, which should be informed that its merchants, after importing according to law, were forbidden to sell the merchandise imported. * * * Such a state of things would break up commerce."

Brown v. *Maryland, supra,* 12 Wheat. (25 U. S.) 419, 447 (Marshall, C. J.).

POINT VI.

Respondent Heacock Company, or its principal, International Silver Company, knew, at the time Heacock Company registered the name Rogers in the Philippines, of petitioner's trade-mark rights in the name Rogers and petitioner's United States registrations containing that name. Consequently, the use of such a registration by Heacock or by International Silver Company to exclude petitioner from selling in the Philippine Islands is unconscionable, and the Philippine courts erred in giving that effect to the registration.

It is obvious from the record, and from the litigations which took place between International Silver Company and petitioner, and their respective predecessors, that International Silver Company was fully aware that its competitor in America was entitled to use the name ROGERS as contained in its American registrations, and that, with knowledge of this, it caused or permitted its agent, Heacock Company, to register, not its own distinc-

tive trade-marks containing the name ROGERS, but the name ROGERS *simpliciter*. The obvious purpose of this was to pirate the name ROGERS and to exclude petitioner from doing business under its trade-marks in the Philippine Islands.

The Philippine Supreme Court expressly found (R. 299) that the Heacock registration was made with the consent of and for the benefit of International Silver Company. It follows, therefore, that any equities between the parties which would operate against International Silver Company if it were a party to this suit, apply as against its agent, Heacock Company.

If it should be admitted, therefore, for the sake of argument only, that under strict construction of the trade-mark laws applicable to the Philippine Islands this registration was technically valid, the use of such a registration to debar the petitioner from selling its goods under its United States trade-marks in the Philippine Islands is an unconscionable use of the registration and a fraudulent misuse of the trade-mark laws. Equity always interferes to prevent an unconscionable use of a legal right. That equitable considerations are applied in respect of the rights of litigants in trade-mark cases in the Philippine Islands, was held by this Court in *Ubeda* v. *Zialcita*, 226 U. S. 452, where it held that a registrant, who was himself an infringer of an earlier mark used by a third person not a party to the suit, could not enforce his registration because of unclean hands.

The situation here is not analogous to that which might exist if the Philippines were an independent government. The Philippine Islands are a possession of the United States, the Trade-Mark Act of 1905 applies to those Islands, and prior to respondents' Philippine registration, the petitioner had registered its marks under the Trade-Mark Act of 1905. And respondent's principal, International Silver Company, was well aware of this.

Heacock Company is not in the position of a local manufacturer or dealer who, independently and innocently, and without knowledge of the rights of others, builds up a local

business under a mark used by another elsewhere, as was the case in *United Drug Company* v. *Rectanus* (248 U. S. 90), and in *General Baking Co.* v. *Gorman* (3 Fed. [2nd] 891). Heacock Company, as the Philippine Supreme Court expressly found, effected its registration

> "with the knowledge, consent and approval of the International Silver Company; in fact, that it was made for its use and benefit" (R. 290),

and International Silver Company had full knowledge of petitioner's rights. Heacock Company effected its registration as an importer, pursuant to the regulations established under the Philippine Trade-Mark Act, which provides that an importer may register the manufacturer's mark in the importer's name, provided he obtains the consent of the manufacturer (Rule 9 of Philippine Rules and Regulations; Appendix III, p. 49, *infra*). Obviously, therefore, Heacock Company obtained and held this registration for the benefit of International Silver Company and it ultimately belongs to International Silver Company.

An importer, even one who has an exclusive agency, does not become the owner of the mark, and if he registers it in his own name, the registered mark belongs to the manufacturer.

See:

Apollinaris Co. v. *Scherrer*, 27 Fed. 18 (S. D. N. Y., 1886);

Soc. Enf. Gombault v. *Lawrence-Williams Co.* (N. D. Ohio, 1926), reported in 16 T. M. Rep. 467;

Munoz & Co. v. *Struckman & Co.*, 9 Phil. 52.

If the decision of the Philippine Supreme Court is sound, then any person can go to the Philippine Islands and pirate trade-marks which long have been used and registered in the United States and thereby exclude their rightful owners from using them in commerce with the Philippine Islands. We do not think that the Court will sanction such disregard of the rights of owners of industrial property to protection of their commerce with the territories of the United States.

CONCLUSION.

In view of the foregoing, it is respectfully submitted that the judgment of the Philippine Supreme Court affirming the judgments of the Court of First Instance in both cases is wrong and should be reversed and that to such an end a writ of certiorari should be granted.

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APPENDIX I.

TRADE-MARK AND TRADE-NAME LAWS OF THE PHILIPPINE ISLANDS

ACT NO. 666 OF MARCH 6, 1903, AS AMENDED

An Act defining property in trade-marks and in trade-names and providing for the protection of the same, defining unfair competition and providing remedies against the same, providing registration for trade-marks and trade-names, and defining the effect to be given to registration under the Spanish royal decree of eighteen hundred and eighty-eight relating to the registration of trade-marks and the effect to be given to registration under this Act.

By authority of the United States, be it enacted by the Philippine Commission, that:

SECTION 1. A trade-mark is a name, emblem, sign, or device, employed by any person, firm, or corporation, to designate the goods dealt in or manufactured by such person, firm or corporation, for the purpose of enabling the public to recognize such goods and manufactures, and to distinguish them from the goods and manufactures of others.

SEC. 2. Anyone who produces, or deals in, merchandise of any kind by actual use thereof in trade may appropriate to his exclusive use a trade-mark, not so appropriated by another, to designate the origin or ownership thereof: *Provided,* That a designation or part of a designation which relates only to the name, quality, or description of the merchandise or geographical place of its production or origin can not be the subject of a trade-mark.

SEC. 3. The ownership or possession of a trade-mark, heretofore or hereafter appropriated, as in the foregoing

section provided, shall be recognized and protected in the same manner and to the same extent, as are other property rights known to the law. To this end any person entitled to the exclusive use of a trade-mark to designate the origin or ownership of goods he has made or deals in, may recover damages in a civil action from any person who has sold goods of a similar kind, bearing such trade-mark, and the measure of the damages suffered, at the option of the complaining party, shall be either the reasonable profit which the complaining party would have made had the defendant not sold the goods with the trade-mark aforesaid, or the profit which the defendant actually made out of the sale of the goods with the trade-mark, and in cases where actual intent to mislead the public or to defraud the owner of the trade-mark shall be shown, in the discretion of the court, the damages may be doubled. The complaining party, upon proper showing, may have a preliminary injunction, restraining the defendant temporarily from use of the trade-mark pending the hearing, to be granted or dissolved in the manner provided in the Code of Civil Procedure, and such injunction upon final hearing, if the complainant's property in the trade-mark and the defendant's violation thereof shall be fully established, shall be made perpetual, and this injunction shall be part of the judgment for damages to be rendered in the same cause as above provided.

SEC. 4. No action shall be brought for damages for the violation of the rights to use trade-marks defined in the preceding sections nor shall criminal proceedings be entertained as provided in section six of this Act, unless it be first shown that the trade-mark or trade-name alleged to have been violated or which gave rise to the criminal action has been duly registered in the Bureau of Commerce and Industry, in accordance with the provisions of this Act. [*As amended by Act No. 3332, sec. 1.*]

SEC. 5. A trade-name is the name, device, or mark by which is intended to be distinguished from that of others

the business, profession, trade, or occupation in which one may be engaged and in which goods are manufactured or sold to the public, work is done for the public, or professional services are rendered to the public. It is not essential that the trade-name should appear on the goods manufactured or dealt in by person owning or using the same. It is sufficient if the trade-name is used by way of advertisements, signs over the place of business, upon letter heads, and in other ways to furnish to the public a method of distinguishing the business, trade, or occupation of the person owning and using such name. Property in trade-names shall be as fully protected as property in a trade-mark by the civil remedies provided in section three of this Act for the protection of property in trade-marks.

SEC. 6. Any person who, with intent to defraud the public or the owner of a trade-mark or trade-name, shall use the trade-mark of another on his goods offered for sale, or the trade-name of another in his business, occupation, or profession, and any person who, knowing that a trade-mark has been fraudulently used on goods with the intent aforesaid, shall sell such goods or offer the same for sale, and any person who shall knowingly aid or abet another in such fraudulent use of a trade-mark or trade-name, shall be punished by a fine of not exceeding two thousand five hundred dollars, or by imprisonment not exceeding three years, or both, in the discretion of the court. Any person who knowing the purposes for which such trade-mark or trade-name is to be used, and that it is the property of one person, prints, lithographs, or in any way reproduces such trade-mark or trade-name, or a colorable imitation thereof, for another person, to enable that other person fraudulently to use such trade-mark or trade-name in the deception of the public and the defrauding of the real owner of the trade-mark or trade-name, shall be punished by a fine not exceeding one thousand dollars, or by imprisonment not exceeding eighteen months, or both, in the discretion of the court.

SEC. 7. Any person who in selling his goods shall give them the general appearance of goods of another manufacturer or dealer, either in the wrapping of the packages in which they are contained, or the devices or words thereon, or in any other feature of their appearance, which would be likely to influence purchasers to believe that the goods offered are those of a manufacturer or dealer other than the actual manufacturer or dealer, and who clothes the goods with such appearance for the purpose of deceiving the public and defrauding another of his legitimate trade, or any subsequent vendor of such goods or any agent of any vendor engaged in selling such goods with a like purpose, shall be guilty of unfair competition, and shall be liable to an action for damages, in which the measure shall be the same as that provided for a violation of trade-mark rights, together with discretionary power in the court to impose double damages, if the circumstances call for the same. The injured party may also have a remedy by injunction similar to that provided for in cases of violation of trade-marks. This section applies in cases where the deceitful appearance of the goods, misleading as to origin or ownership, is effected not by means of technical trade-marks, emblems, signs, or devices but by the general appearance of the package containing the goods, or by the devices or words thereon, even though such packages, devices, or words are not by law capable of appropriation as trade-marks; and in order that the action shall lie under this section, actual intent to deceive the public and defraud a competitor shall affirmatively appear on the part of the person sought to be made liable, but such intent may be inferred from similarity in the appearance of the goods as packed or offered for sale to those of the complaining party.

SEC. 8. Any person guilty of unfair competition, as defined in the preceding section, in addition to the civil remedies to which he may be subject, shall also be liable criminally, in case of conviction for the same, to a fine of not exceeding two thousand dollars, or imprisonment

not exceeding two years, or both, in the discretion of the court.

SEC. 9. No action, or suit, or criminal prosecution shall be maintained under the provisions of this Act in any case where the violation of the trade-mark or trade-name or the unfair competition complained of has been in any unlawful business, or with respect to any article, trade in which is unlawful, or is against public policy, or in any case where the trade-mark, trade-name, or the indicia of origin, ownership, or manufacture have been used by the complaining and injured party for the purpose of himself deceiving the public with respect to the character of the merchandise sold by him or of the business or profession or occupation carried on by him.

SEC. 10. The use of a registered trade-mark or trade-name by the assignee of the owner of such trade-mark or trade-name shall be lawful and shall be protected under this Act, if such assignment is made of record in the register of the Bureau of Commerce and Industry. [*As amended by Act No. 3332, sec. 2.*]

SEC. 11. The owners of trade-marks or trade-names domiciled in the Philippine Islands, or the United States, or in any foreign country which by treaty, convention, or law affords similar privileges to the citizens of the United States and of the Philippine Islands, may obtain registration of such trade-marks or trade-names by complying with the following requirements:

First. By causing to be recorded in the Bureau of Commerce and Industry a statement specifying the name, domicile, location, and citizenship of the applicant; the general class or classes of merchandise to which the trade-mark claimed has been appropriated; or in case of a trade-name the description of the business, profession, or occupation it is to distinguish; a description of the trade-mark or trade-name itself, with facsimiles thereof, and a statement of the mode in which the same is applied and affixed

to goods, or is to be used in the business, profession, or occupation, and the length of time during which the trade-mark or trade-name has been used. [*As amended by Act No. 1407, sec. 3(b), and modified by Act. No. 2728.*]

Second. By paying to the Bureau of Commerce and Industry the sum of twenty-five dollars in money of the United States and complying with such regulations as may be prescribed by the Director of said Bureau. [*As amended by Act. No. 1407, sec. 3(b), and modified by Act No. 2728.*]

SEC. 12. The application prescribed in the foregoing section must be accompanied by a written declaration verified by the person, or by a member of the firm, or by an officer of the corporation applying, or by the duly authorized attorney or agent of such person, firm, or corporation, to the effect that such party has at the time a right to the use of the trade-mark or trade-name sought to be registered, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; and that the description and facsimiles presented for registry truly represent the trade-mark sought to be registered. [*As amended by Act No. 744, sec. 4.*]

SEC. 13. The time of the receipt of any such application shall be noted and recorded. But no alleged trade-mark or trade-name shall be registered which is merely the name, quality, or description of the merchandise upon which it is to be used or the geographical place of its production or origin, or which is identical with a registered or known trade-mark owned by another and appropriate to the same class of merchandise, or which so nearly resembles another person's lawful trade-mark or trade-name as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers. In an application for registration the Director of the Bureau of Commerce

and Industry shall decide the presumptive lawfulness of claim to the alleged trade-mark. [*As amended by Act No. 1407, sec. 3(b), and modified by Act No. 2728.*]

SEC. 14. No article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or shall copy or simulate a trade-mark or trade-name registered in accordance with the provisions of this Act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the Philippine Islands, shall be admitted to entry at any customhouse of the Philippine Islands; and in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade-mark or trade-name issued in accordance with the provisions of this Act, to be recorded in books which shall be kept for this purpose in the office of the Insular Collector of Customs, under such regulations as the Insular Collector of Customs, with the approval of the Secretary of Finance and Justice, shall prescribe, and may furnish to the office of the Insular Collector of Customs a facsimile of his name, the name of the locality in which his goods are manufactured, and of his registered trade-mark or trade-name; and thereupon the Insular Collector of Customs shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs: *Provided, however,* That this section shall not be construed to affect rights that any person may have acquired by virtue of having registered a trade-mark under the laws of the United States.

In matters arising under this section original jurisdiction is hereby conferred upon the Court of First Instance, and appellate jurisdiction upon the Supreme Court, identical with the jurisdiction conferred upon such courts by section twenty-six of the Act of Congress approved August fifth, nineteen hundred and nine, entitled "An Act to

raise revenue for the Philippine Islands, and for other purposes." [*As amended by Act No. 2460.*]

SEC. 15. Certificates of registration of trade-marks and trade-names under the Spanish sovereignty in these Islands unannulled, under the royal decree of eighteen hundred and eighty-eight, shall be conclusive evidence of the exclusive right of ownership of such trade-marks or trade-names in respect to the goods and articles of merchandise or the business, profession, or occupation to which they by the terms of the registration apply. [*As amended by Act No. 2460.*]

SEC. 16. Certificates of registry of trade-marks and trade-names, shall be issued in the name of the Insular Government of the Philippine Archipelago, under the seal of the Bureau of Commerce and Industry and shall be signed by the Director of said Bureau and a record thereof, together with printed copies of the specific trade-marks or trade-names, shall be kept by him in books for that purpose. Certified copies of trade-marks or trade-names and of statements and declaration filed therewith, and original certificates of registry, shall be evidence in any suit in which such trade-marks or trade-names shall be brought into controversy. But registration of trade-marks and trade-names under this Act shall only be *prima facie* evidence of the exclusive right by the person securing the registration to use the same. [*As amended by Act No. 803, sec. 1; Act No. 1407, sec. 3(b); Act No. 2460 and modified by Act No. 2728.*]

SEC. 17. A certificate of registry shall remain in force for thirty years from its date, except in cases where the trade-mark is claimed for, and applied to, articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this Act at the time that such trade-mark ceases to be exclusive property elsewhere. At

any time during the six months prior to the expiration of the term of thirty years, such registration may be renewed on the same terms and for a like period. [*As amended by Act No. 2460.*]

SEC. 18. Applicants for registration under this Act shall be credited for any fee or part of a fee heretofore paid into the Bureau of Commerce and Industry with intent to procure protection for the same trade-mark or trade-name. [*As amended by Act No. 1407, sec. 3(b); Act No. 2460 and modified by Act No. 2728.*]

SEC. 19. Any person who shall procure the registry of a trade-mark, or of himself as the owner of a trade-mark or trade-name, or an entry respecting a trade-mark or trade-name, in the Bureau of Commerce and Industry, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, or any person who shall aid or abet such fraudulent procuring of registry, shall be liable to pay any damages sustained in consequence thereof to the injured party; and shall further be liable to criminal prosecution, and upon conviction shall be punished by a fine of not more than one thousand dollars, or imprisonment for not more than one year and one day, or both, in the discretion of the court. [*As amended by Act No. 1407, sec. 3(b); Act No. 2460 and modified by Act No. 2728.*]

SEC. 20. The Director of the Bureau of Commerce and Industry is hereby authorized to make the necessary rules and regulations for the purposes of this Act and likewise to prescribe forms for the transfer of the right to use trade-marks or trade-names and for recording such transfers in his office. He is also authorized to establish classes of merchandise for the purpose of the registration of trade-marks and to determine the particular description of the articles included in each class. An application for registration of a trade-mark shall be registered only for one class of articles and only for the particular description

of articles mentioned in such application: *Provided,* That such description of articles shall be comprised in only one class. [*As amended by Act No. 1407, sec. 3(b); Act No. 2460; Act No. 3332, sec. 3; and modified by Act. No. 2728.*]

SEC. 21. The citizens and residents of this country wishing the protection of trade-marks in any foreign country, the laws of which require registration here as a condition precedent to getting such protection there, may register their trade-marks for that purpose, as is above allowed to foreigners, and have certificate thereof from the Director of the Bureau of Commerce and Industry upon payment of the same fee as that required by section eleven. [*As amended by Act No. 1407, sec. 3(b); Act No. 2460 and modified by Act No. 2728.*]

SEC. 22. All the duties appertaining to the Bureau of Patents, Copyrights, and Trade-marks are hereby devolved upon the Director of the Bureau of Commerce and Industry. [*As amended by Act No. 1407, sec. 3(b); Act No. 2460 and modified by Act No. 2728.*]

SEC. 23. The royal decree of eighteen hundred and eighty-eight as to the registration of trade-marks, as continued in force by military order, is hereby repealed. [*As amended by Act No. 2460.*]

SEC. 24. This Act shall take effect on its passage. [*As amended by Act No. 2460.*]

APPENDIX II.

Act No. 2460 of February 4, 1915.—An Act to amend Act Numbered Six hundred and sixty-six, entitled "An Act defining property in trade-marks and in trade-names and providing for the protection of the same, defining unfair competition and providing remedies against the same, providing registration for trade-marks and trade-names, and defining the effect to be given to registration under the Spanish royal decree of eighteen hundred and eighty-eight relating to the registration of trade-marks, and the effect to be given to registration under this Act," by forbidding the importation of certain merchandise, and for other purposes.

By authority of the United States, be it enacted by the Philippine Legislature, that:

SECTION 1. Act Numbered Six hundred and sixty-six, entitled "An Act defining property in trade-marks and in trade-names and providing for the protection of the same, defining unfair competition and providing remedies against the same, providing registration for trade-marks and trade-names, and defining the effect to be given to registration under the Spanish royal decree of eighteen hundred and eighty-eight relating to the registration of trade-marks, and the effect to be given to registration under this Act," is hereby amended by inserting the following as section fourteen, changing the present section numbers fourteen to twenty-three, inclusive, to fifteen to twenty-four, inclusive:

"SEC. 14. No article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or shall copy or simulate a trade-mark or trade-name registered in accordance with the provisions of this Act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the Philippine Islands, shall

be admitted to entry at any customhouse of the Philippine Islands; and in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade-mark or trade-name issued in accordance with the provisions of this Act, to be recorded in books which shall be kept for this purpose in the office of the Insular Collector of Customs, under such regulations as the Insular Collector of Customs, with the approval of the Secretary of Finance and Justice, shall prescribe, and may furnish to the office of the Insular Collector of Customs a facsimile of his name, the name of the locality in which his goods are manufactured, and of his registered trade-mark or trade-name; and thereupon the Insular Collector of Customs shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs: *Provided, however,* That this section shall not be construed to affect rights that any person may have acquired by virtue of having registered a trade-mark under the laws of the United States.

"In matters arising under this section original jurisdiction is hereby conferred upon the Court of First Instance, and appellate jurisdiction upon the Supreme Court, identical with the jurisdiction conferred upon such courts by section twenty-six of the Act of Congress approved August fifth, nineteen hundred and nine, entitled 'An Act to raise revenue for the Philippine Islands, and for other purposes.'"

APPENDIX III.

REVISED RULES AND REGULATIONS GOVERNING THE REGISTRATION OF TRADE-MARKS AND TRADE-NAMES ISSUED BY THE BUREAU OF COMMERCE AND INDUSTRY PURSUANT TO SECTION 20 OF ACT No. 666 AS AMENDED.

The following rules and regulations issued in accordance with the provisions of section 20 of Act No. 666 as amended, are hereby promulgated for the proper transaction of business with the Bureau of Commerce and Industry with regard to the registration of trade-marks and trade-names.

9. Any importer desiring to register the trade-mark of the articles imported by him may do so either in the name of the owner of the mark or in his own name; in the latter case he shall be required to file in this office with the application papers a document executed by the owner of the mark authorizing such importer to register the mark in the latter's name. Such document must be duly acknowledged or sworn to before an officer authorized to do so.

APPENDIX IV.

TRADE-MARK LAW OF THE UNITED STATES

ACT OF FEBRUARY 20, 1905, C. 592. 33 STAT. 724
(AS AMENDED)

SECTION 1. The owner of a trade-mark used in commerce with foreign nations, or among the several States, or with Indian tribes, providing such owner shall be domiciled within the territory of the United States, or resides or is located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens

of the United States, may obtain registration for such trade-mark by complying with the following requirements: * * *

SEC. 5. No mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

(a) Consists of or comprises immoral or scandalous matter.

(b) Consists of or comprises the flag * * *:

Provided, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, * * * shall be registered under the terms of this Act.

SEC. 16. The registration of a trade-mark under the provisions of this Act shall be prima facie evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark * * * and shall use or shall have used, such reproduction, counterfeit, copy or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; * * *

SEC. 29. In construing this Act the following rules must be observed, except where the contrary intent is plainly apparent from the context thereof: The United States includes and embraces all territory which is under the jurisdiction and control of the United States. The word "States" includes and embraces the District of Columbia, the Territories of the United States, and such other territory as shall be under the jurisdiction and control of the United States.

APPENDIX V.

TARIFF ACT FOR THE PHILIPPINE ISLANDS

ACT OF CONGRESS OF AUGUST 5, 1909 (C. 8, 36 STAT. 130-177).

SEC. 26. That original jurisdiction in all cases arising in the Philippine Islands is hereby conferred upon the courts of first instance of the Philippine Islands and appellate jurisdiction upon the Supreme Court of the Philippine Islands in matters arising under the Act of Congress approved February 20, 1905, entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the other States or with Indian tribes and to protect the same," identical with the jurisdiction conferred upon courts of the United States by section Seventeen of said Act.

APPENDIX VI.

"THE JONES LAW"

AUTONOMY ACT

THE ORGANIC ACT FOR THE PHILIPPINE ISLANDS

(Act of Congress of August 29, 1916, 39 Stat. 545)

C. 416—An Act to declare the purpose of the people of the United States as to the future political status of the people of the Philippine Islands, and to provide a more autonomous government for those islands.

SEC. 5. That the statutory laws of the United States hereafter enacted shall not apply to the Philippine Islands, except when they specifically so provide, or it is so provided in this Act.

SEC. 10. That while this Act provides that the Philippine government shall have the authority to enact a tariff law the trade relations between the islands and the United States shall continue to be governed exclusively by laws of the Congress of the United States: *Provided,* That tariff acts or acts amendatory to the tariff of the Philippine Islands shall not become law until they shall receive the approval of the President of the United States, nor shall any act of the Philippine Legislature affecting immigration or the currency or coinage laws of the Philippines become a law until it has been approved by the President of the United States: *Provided further,* That the President shall approve or disapprove any act mentioned in the foregoing proviso within six months from and after its enactment and submission for his approval, and if not disapproved within such time it shall become a law the same as if it had been specifically approved.

SEC. 26. That the supreme court and the courts of first instance of the Philippine Islands shall possess and exercise jurisdiction as heretofore provided and such additional jurisdiction as shall hereafter be prescribed by law. The municipal courts of said islands shall possess and exercise jurisdiction as now provided by law, subject in all matters to such alteration and amendment as may be hereafter enacted by law; and the chief justice and associate justices of the supreme court shall hereafter be appointed by the President, by and with the advice and consent of the Senate of the United States. The judges of the court of first instance shall be appointed by the Governor General, by and with the advice and consent of the Philippine Senate: *Provided,* That the admiralty jurisdiction of the supreme court and courts of first instance shall not be changed except by Act of Congress. That in all cases pending under the operation of existing laws, both criminal and civil, the jurisdiction shall continue until final judgment and determination.

APPENDIX VII.

CUSTOMS REGULATIONS GOVERNING THE EXCLUSION OF IMPORTED PRODUCTS BEARING MARKS OR NAMES THAT IMITATE REGISTERED TRADE-MARKS OR TRADE-NAMES.

(Customs Administrative Order No 194)

January 13, 1926

Trade-marks and Trade-names; Laws relative thereto and regulations governing the exclusion of imported products bearing marks or names that imitate registered trade-marks or trade-names; Customs Administrative Circular No. 730, superseded.

PARAGRAPH 1. Act No. 666 of the Philippine Legislature, as amended by Acts Nos. 744, 803, and 2460, contains the rules and regulations of the Government of the Philippine Islands relative to property in *domestic* trade-marks and trade-names and the protection to be afforded the owners thereof, while the Act of Congress of February 20, 1905, as amended, provides for the registration and protection of trade-marks used in connection with *foreign* nations or between the Philippine Islands and the several States of the United States.

(Published in official publication of the Philippine Government, 1927, entitled "Laws, Rules, and Regulations governing the registration of trade-marks and trade-names in the Philippine Islands"; quoted in the record in this case, R. 400-401.)

APPENDIX VIII.

CUSTOMS REGULATIONS OF 1908.

(United States Treasury Department, Rules and Regulations, Vol. 3, p. 159)

ART. 325. Insular territory.—The provisions of the act of February 20. 1905, apply to Porto Rico, the Philippine Islands, Hawaii, and any other territory under the jurisdiction and control of the United States.